

### **REMARKS**

Amended herewith are formal drawings that are to be substituted for those currently on file. It is believed that these formal drawings overcome the objections set forth by the Examiner with regard to the drawings originally filed.

The Examiner, in paragraphs 2 and 3, has rejected claims 5 and 6 under 35 USC § 112 second paragraph as being indefinite for the reasons set forth therein. Claims 5 and 6 have been cancelled and claim 1 has been amended to include the general subject matter of old claim 5. The amendment to claim 1 has been made to overcome the objections set forth by the Examiner. In particular, claim 1 now specifically sets forth that information regarding the position of said subject obtained from said digital image is used for producing said cut image product. Support for this change may be found on page 5, lines 20-23. Thus, the cutter that is used to make the cut image product uses the information regarding the position of the subject matter that was obtained using the digital image. There is no teaching or suggestion in any of the references of providing such a feature. The same feature has also been added to independent claim 18.

Two new independent claims have been added that correspond to old claims 1 and 18 respectively with the additional limitation that was previously set forth in claim 6 amended to overcome the objections under 35 USC § 112 second paragraph. In particular, these claims now include the limitation that machine readable information is provided on the media that can be read by a cutting device that is used to produce the cut image product. Support for this may be found on page 5, lines 23-28. It is respectfully submitted that none of the prior art references teach or suggest this feature.

The Examiner rejected claims 1-5, 7-9 and 16-18 under 35 USC § 103(a) as being unpatentable over Kinjo (US 6,519,046) and Miyazaki et al. (US 6,619,166) for the reasons set forth therein. Applicant respectfully submits that neither of these references either individually or in combination teach or suggest the invention as taught and claimed by Applicants.

With respect to the '046 reference, it is clear that this does not teach or suggest the method of making a cut image product as taught and claimed by Applicant. In particular, it is evident that this reference is not directed to a cut image product to which the present invention is directed. This reference discloses

**Amendments to the Drawings:**

Formal drawings are submitted herewith under separate Letter to the Draftsperson which incorporate the changes required by the Examiner.

Approval by the Examiner is respectfully requested.

Attachment: Replacement Figures 1, 2a,b,c, 3a,b,c,d, 4a,b,c, 5, 6a,b, 7a,b,c

the obtaining of an image and identifying a particular area or part thereof to be used or designated as an ornamental pattern (see column 18, lines 4 through column 19, line 18). As further set forth at column 19, lines 38 et al., the printer reads the registered ornamental pattern from the ornamental data table and converts the graphic pixels of the graphic image in accordance with the registered ornamental pattern as shown for example in Figs. 24A and 24B. Clearly, there is no teaching or suggestion of providing a cut image product as taught and claimed by Applicant. Further, since it is not directed to a cut image product as taught and claimed by Applicant, it could not teach or suggest the providing of information regarding the position of the subject obtained from the digital image and using such for producing the cut image product. Applicants respectfully submit that this reference is not relevant to the invention as set forth in independent claims 1 and 18. Independent claims 19 and 20 include the limitation of providing machine readable indicia on a media that can be read by a cutting device that are used to produce the cut image product. Here again, the '046 reference could not teach or suggest the invention as taught and claimed by Applicant.

The '166 reference is directed generally to a printing apparatus with a cutter wherein the cutter is used to cut images that are identified in a desired size and layout. In particular, there is provided selecting a cutting pattern from a plurality of cutting patterns (see column 2, lines 19 and 20). As discussed at column 10, lines 58 through column 12, line 23, there is disclosed a process by which a user selects layout and image shapes from selections made available to the user. The first step is the selection of an image illustrated by 10A in Figure 16. Then a layout, as illustrated by 10C of Figure 16 is selected. A plurality of punching shapes are shown in display part 10B of Figure 16. These items are selectable items (see column 10, lines 62-65). Template images such as those set forth in Figures 20A, 20B and 20C are used in conjunction with images to produce composite images as set forth in Figures 21A, 21B and 21C respectively. These images are printed in a pattern in accordance with a selected layout. There is no teaching or suggestion of identifying a subject in an image and then cutting an image as taught and claimed by Applicants.

The Examiner has attempted to combine the two references claiming there is motivation and teaching to do so. The motivation would have been to provide a user with many more options for output of images. To bolster

this argument the Examiner states that the inventions of Miyazaki et al. and Kinjo would be combined because they are both developed by the same assignee.

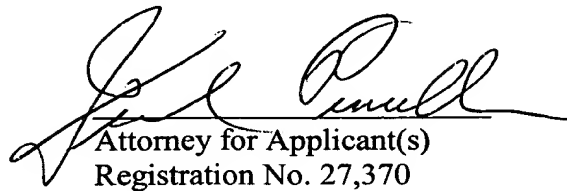
In order to properly combine references there must be some teaching or motivation to make the combination. The CAFC in *In re Lee* 277 Fed 3<sup>rd</sup> 1338 (61 USPQ 2<sup>nd</sup> 1430) 2002 stated:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness ... factual inquiry whether to combine references must be thorough and searching ... it must be based on objective evidence of record ... Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references ... (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant)."

The cited two references are directed to two totally different and distinct objectives. While they may be owned by the same assignee, this is not the test to determine whether references may be combined. It should be noted that the subject assignee is a large corporation having many thousands of patents. It would hardly seem obvious to take any one particular patent and combine it with any other particular patent unless there was a clear motivation to make the combination as required by case law. Furthermore, even if one were to make the combination as suggested by the Examiner, the combined references still fail to teach the cutting of the media as taught and claimed by Applicant. Neither reference individually or in combination teach or suggest providing of information regarding the position of the subject that is obtained from the digital image and used for producing the cut image product or that machine readable indicia is provided on a media that can be read by a cutting device that is used to produce the cut image product. Thus, the prior art failing to disclose these limitations is a clear indication of the allowability of the subject claims.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

  
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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.